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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,105	01/17/2002	Kenji Hatada	360842007400	1303
7590 11/23/2004 Barry E Bretschneider Morrison & Foerster 2000 Pennsylvania Avenue N W Washington, DC 20006-1888			EXAMINER KRUER, KEVIN R	
			ART UNIT 1773	PAPER NUMBER

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b> 09/787,105	<b>Applicant(s)</b> HATADA, KENJI
	<b>Examiner</b> Kevin R Kruer	<b>Art Unit</b> 1773

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 28 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.

Claim(s) objected to: NONE.

Claim(s) rejected: 1-3, 5, 7-11, and 22.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

### **Advisory Action**

Applicant's arguments filed October 28, 2004 have been fully considered but they are not persuasive.

Applicant argues that there is no requirement to cancel non-elected claims in the response to the final Action when the election is without traverse. The examiner agrees. Claims 12-21 are currently withdrawn as being drawn to a non-elected invention without traverse.

With regard to the 37 CFR 1.131 Declaration filed March 8, 2004, Applicant argues the declaration is fully commensurate with the claimed invention of claim 1 and is, therefore, sufficient to antedate the teachings of Fujita. The examiner respectfully disagrees with applicant's conclusion. The declaration presented in the declaration is drawn to a polymer resin layer (herein referred to as "A") applied over a metal layer (herein referred to as "B") deposited on a substrate (herein referred to as "C"). Thus, the declaration shows possession of an A-B-C laminate. The reference which applicant is attempting to antedate shows a polymer resin layer applied between a substrate and a deposited metal layer; a C-A-B laminate. Thus, the declaration fails to show the species disclosed in Fujita. As noted in MPEP 715.03(R-2), "Where generic claims have been rejected on a reference or activity which discloses a species not antedated by the affidavit or declaration, the rejection will not ordinarily be withdrawn." When the declaration fails to show possession of the species disclosed in the reference, a 37CFR 1.131 declaration is deemed sufficient for antedating a reference applied to a genus claim when there is "proof of prior completion of a species different from the species of

the reference” and “the species shown in the reference would have been obvious in view of the species shown to have been made by the applicant.” The declaration does include proof of prior completion of a species different from the species of the reference. However, the examiner maintains the position that the declaration is insufficient for antedating Fujita because the species shown in the reference would not have been obvious in view of the species shown to have been made by the applicant. The species shown by applicant utilizes the polymer resin layer as an overcoat layer. The species taught by Fujita utilizes the polymer resin layer as a primer layer. One of ordinary skill in the art would not have concluded that it would have been obvious to utilize an overcoat layer as a primer layer. Clearly, the polymer resin layers of the declaration and Fujita, respectively, are performing separated and distinct functions. Thus, the rejection based upon the teachings of Fujita is maintained.

With respect to the combination of Mokerji and Pottorff, the examiner took the position that it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the plastic substrate of Mokerji windable so that said substrate may be easily stored. Applicant argues that the examiner’s motivation for combining Mokerji and Pottorff is not plausible in light of the fact that Mokerji’s invention is related to chrome plated articles “such as for example, a wheel cover.” The examiner respectfully disagrees with applicant’s interpretation of Mokerji. Mokerji is broadly directed to any laminate comprising metal deposited on a plastic substrate (see abstract and col 1, lines 44+) and is not limited to plastics substrates that are shaped or of definite length, such as wheel cover. The examiner relied upon Pottorff to provide

motivation for utilizing a windable polymer film as the substrate taught in Mokerji.

Specifically, such windable polymer films are easily stored. Thus, applicant's argument is not persuasive.

Applicant further argues that the examiner's motivation is so general that the examiner could have simply alleged without resorting to Pottorff that plastic materials are typically made windable so that they can be stored as rolls. Applicant seems to taking the position that the examiner could have taken official notice that plastic films are typically made windable so that they can be stored and that such knowledge was within the level of ordinary skill in the pertinent art. If such knowledge was within the level of skill of the ordinary artisan, then the examiner must respectfully disagree with applicant's assertion that the motivation for making the film of Mokerji windable was "impermissible hindsight."

Applicant further argues that the examiner's motivation applies to virtually every invention having plastic material, regardless of what it might be. The examiner disagrees with applicant's conclusion. Clearly, the prior art does not suggest that shaped, rigid, or definite-length plastics could be wound. However, the substrate of Mokerji is not limited with regard to shape, rigidity or length and may comprise "any suitable material" (col 1, lines 44+). The examiner acknowledged that such as teaching does not anticipate a windable substrate but determined, based upon the Graham factors, that one of ordinary skill in the art would have been motivated to make the substrate windable so that the laminate may be easily stored (as taught by Pottorff). Thus, Pottorff demonstrates that the feature not taught by Mokerji was known in the art

and provides motivation to one of ordinary skill in the art to modify the teachings of Mokerji. Thus, the examiner maintains the position that a prima facie showing has been established.

Applicant further argues that there is no suggestion that one of ordinary skill in the art would have been able to make the plastic substrate of Mokerji windable while still maintaining the plastic substrate as a component of the chrome plated articles of Mokerji. The examiner respectfully disagrees. Mokerji teaches that the substrate may comprise any plastic material and is non-limiting with regard to physical properties of the substrate. Thus, one of ordinary skill in the art would conclude with reasonable certainty that a windable substrate would not make the invention of Mokerji inoperable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'K-R-K' with a stylized flourish at the end.

Kevin R. Kruer  
Patent Examiner-Art Unit 1773